

DOCKET NO: 290617US28PCT

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF

:

IPPEI SHAKE, ET AL.

: EXAMINER: MANSOURY, N

SERIAL NO: 10/577,874

:

FILED: APRIL 28, 2006

: GROUP ART UNIT: 2419

FOR: PACKET TRANSMISSION
METHOD AND PACKET
TRANSMISSION DEVICE

:

PROVISIONAL ELECTION

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

In response to the restriction requirement mailed June 10, 2009, Applicants provisionally elect with traverse Invention I, identified in the outstanding Official Action as corresponding to Claims 1-19, for further examination on the merits. Applicant reserves the right to file one or more divisional applications directed to non-elected inventions.

Furthermore, while the Restriction Requirement asserts that the application contains claims to patentably distinct inventions, the requirement improperly relies on the guidelines in §800 of the MPEP.

Specifically, Applicant respectfully traverse this Restriction Requirement for the reason that Inventions I-VII have not been treated relative to making a showing of a lack of unity of invention as required by MPEP §1893.03(d), MPEP §1850, and 37 CFR § 1.475. In this regard, this is a national stage application filed under 35 U.S.C. §371 and unity of invention guidelines, not MPEP section 800 guidelines, must be used.

In this last regard, MPEP §1893.03(d) establishes that to show lack of “unity of invention”, the Examiner “must (1) list the different groups of claims and (2) explain why each group lacks unity with each other group (i.e., why there is no single general inventive concept) specifically describing the unique special technical feature in each group” (emphasis added).

As MPEP §1893.03(d) further makes clear, a process is described as specially adapted for the manufacture of a product if the claimed process inherently produces the claimed product whether or not the product can be manufactured by a different process. Accordingly, the practice under MPEP §806.05(f) not only should not be used for this application, it is not controlling as to determining “unity of invention” because merely showing that a product can be manufactured by a materially different process does not show that the process as claimed is not “specially adapted” for manufacturing the product, all as set forth in the MPEP.

Applicants also note that the further requirements as to establishing a lack of “unity of invention” are set forth in MPEP §1850.

Thus, based on the “unity of invention” standard, Applicants note that at least Claims 20-38 should be included with Claims 1-19 as these claims relate to a packet transfer apparatus corresponding to the packet transfer method recited in Claims 1-19 and share a common inventive concept with these claims.

Therefore, it is respectfully requested that the requirement to elect a single invention be withdrawn, and that a full examination on the merits of the claims be conducted.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

James J. Kulbaski
Attorney of Record
Registration No. 34,648

James Love
Registration No. 58,421

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 08/07)

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